



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/674,024	05/14/2001	Nemo Semret	A32038-PCTUS	8957
21003	7590	01/30/2004	EXAMINER	
BAKER & BOTTS 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			SNAPP, SANDRA S	
		ART UNIT	PAPER NUMBER	
		3624		

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/674,024	SEMRET ET AL.
	Examiner	Art Unit
	Sandra Snapp	3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 25 May 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-42 is/are rejected.
- 7) Claim(s) 16-18 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 25 May 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> . | 6) <input type="checkbox"/> Other: _____ .                                   |

## **DETAILED ACTION**

### ***Priority***

The Examiner acknowledges the Applicants claim for priority to PCT/US99/06384 filed on March 23, 1999.

### ***Specification***

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

### ***Claim Objections***

Claims 16-18 are objected to because of the following informalities:

In claim 16, the term “component” should be in the plural form “components” so as to be consistent with a plurality thereof.

In claim 17, the phrase “said quantity components” should be “said *plurality* of quantity components to be consistent with the language of claim 16.

In claim 18, the phrase “new’s bids” should actually be “new bid’s” if the Applicant is referring to the new bids previously referenced in claim 18.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

Art Unit: 3624

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4-13, 15, 18, 21, 25-28, 31, 33, 34, 38-40 and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 18 and 34 are confusing because it is unclear what is really happening when a resource is first allocated to at least one bid with a price component higher than the price component of the new bid, and then the resource (assuming the same resource) is allocated again to the new bid responsive to the first allocation step. Is the same resource allocated twice? Clarification is required.

Claim 4 is indefinite because the phrase “said allocated resource” is confusing. It is unclear which allocated resource is referred to, as claim 1 first allocates the resource and then allocates the resource in a subsequent step. Which allocated resource is desired in claim 4?

Claim 5 is indefinite because it is unclear because the phrase “said retrieved at least one bid” is inconsistent with the retrieved *data* of claim 1. In claim 1 there is no ‘retrieved bids’ only retrieved data. Applicant needs to clarify what they are trying to order in claim 5.

Claims 6 and 13 are indefinite because it is unclear which “allocation steps” are being referred to in claim 6 since there are two different “allocating” steps in claim 1. If only one of the allocation steps being referred to or both?

Claim 7 is indefinite because the phrase “said first allocation” lacks proper antecedent basis. There is no previous reference to a *first allocation*.

Claim 8 is indefinite because it is confusing if the phrase “an initial allocation” is the same as the “first allocating” of claim 1 or a different allocation.

Claims 9 and 11 are indefinite because the phrase “said retrieved bid” lacks proper antecedent basis. In claim 1 there is retrieved data, and two sets of data at that. It is unclear what the Applicant is referring to by using the phrase “said retrieved *bid*.”

Claims 10 and 12 are indefinite because phrase “said retrieved bids” lacks proper antecedent basis. In claim 1 there is retrieved data, and two sets of data at that. It is unclear what the Applicant is referring to by using the phrase “said retrieved *bids*.”

Claim 15 is indefinite because the phrase “said allocation” lacks proper antecedent basis. There is no previous reference to an *allocation* only ‘allocating resources’ in claim 1.

Claim 21 is indefinite because the phrase “said retrieved at least one first bid” lacks proper antecedent basis.

Claims 25 and 27 are indefinite because the phrase “said second bid’s” lacks proper antecedent basis. Also, it is unclear which retrieved bid is being referred to because in claim 18 there are two means for retrieving bids.

Claims 26 and 28 are indefinite because the phrase “said received bids” lacks proper antecedent basis.

Claims 31 and 33 are indefinite because the phrase “said allocation means” is confusing since there is a “means for first allocating” and a “means for allocating” both in claim 18. Which allocation means is being referred to in claims 31 and 33?

Claim 34 is indefinite because ‘a bidding entity for providing bids’ and a ‘new bidding entity for providing at least one bid’ are confusing, perhaps a first bidding entity and a second bidding entity would be a better way to delineate between the two different bidding entities.

Claims 38 and 40 are indefinite because the phrase “said retrieved bid” lacks proper antecedent basis.

Claim 39 is indefinite because the phrase “said received bids” lacks proper antecedent basis.

Claim 42 is indefinite because the phrase “said allocation” lacks proper antecedent basis.  
Also there are two different allocating steps in claim 34.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-12, 14-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to non-statutory subject matter because they lack any reference to technology. The Board of Patent Appeals and Interferences has taken the position that for claims to satisfy the statutory requirements of 35 U.S.C. 101, they must claim some form of technology, i.e. a computer or the like. The Board stated in *Ex parte Bowman*, claims that lack any reference to technology “are nothing more than abstract idea which is not tied to any technological art and is not a useful art as contemplated by the Constitution.” *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001)

(Unpublished). While the Bowman opinion is not precedential, it is cited herein for its content and reasoning.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-42 are rejected under 35 U.S.C. 102(e) as being anticipated by the Ausubel patent (US 5,905,975).

The Ausubel patent discloses a method of allocating a resource and its associated apparatus, comprising the steps/elements of:

Means for retrieving data indicative of at least one bid comprising a quantity data component and a price data component (col. 11, lines 15-32), means for retrieving second data indicative of a new bid comprising a quantity component and a price component (col. 11, lines

Art Unit: 3624

15-32), means for first allocating the resource to the at least one bid with a price component higher than the price component of the new bid (col. 11, lines 35-43), means for allocating the resource to the new bid responsive to the first allocation step (col. 11, line 54 to col. 12, line 19), means for calculating the new bid's cost responsive to the price component of at least one bid with a price component lower than the price component of the new bid (col. 12, lines 7-19), and means for storing cost data indicative of the calculated cost (col. 12, lines 50-54) (claims 1, 18 and 34);

The resource is bandwidth (spectrum rights, col. 7, lines 30-35) (claims 2, 19 and 35);

The new bid's resource allocation and the calculated cost are transmitted to an entity who made the new bid (col. 12, lines 7-19) (claim 3);

The allocated resource is utilized by an entity associated with the bid (col. 12, lines 7-19) (claim 4);

Means for ordering the retrieved at least one bid by the at least one bid's price component (col. 11, lines 5-14) (claims 5 and 21);

Means for retrieving data indicative of the resource's maximum capacity and wherein the allocation steps are responsive to the maximum capacity (col. 11, lines 15-32) (claims 6, 22 and 37);

The resource is allocated to the new bid only if the first allocation is less than the maximum capacity (col. 12, lines 7-19) (claims 7 and 23);

An initial allocation of the resource is performed before the new bid is processed (col. 12, lines 7-19) (claims 8 and 24);

Calculating the new bid's cost is responsive to at least the retrieved bid with data indicative of the lowest price component which has been allocated in the initial allocation (col. 12, lines 7-19) (claims 9, 25 and 38);

Calculating the new bid's cost is responsive to a plurality of the retrieved bids with data indicating the prices which are lower than the new bid (col. 11, lines 15-32) (claims 10, 26 and 39);

Calculating the new bid's cost is responsive to at least the retrieved bid with data indicative of the lowest price which would have received an allocation if the new bid was not retrieved (col. 11, lines 15-32) (claims 11, 27 and 40);

Calculating the new bid's cost is responsive to a plurality of the received bids with data indicative of prices lower than the new bid (col. 11, lines 15-32) (claims 12 and 28);

One of the at least one bid is submitted by a processor performing the allocation step (cpu, col. 8, lines 1-20 and col. Col. 11, lines 5-32) (claim 13);

The at least one bid comprises valuation data comprising a plurality of price components associated with a plurality of quantity components (col. 11, lines 15-32) (claims 14, 30 and 41);

The allocation is responsive to the plurality of price components and the quantities components (col. 12, lines 7-19) (claims 15, 31 and 42);

The new bid comprises valuation data comprising a plurality of price components associated with a plurality of quantity components (col. 12, lines 7-19) (claims 16 and 32);

The allocation is responsive to the new bid's plurality of price components and the quantity components (col. 11, lines 15-32) (claim 17);

Means for storing data indicative of the cost (memory, col. 8, lines 5-8) (claim 20);

One of the at least one bids is submitted by an operator of the apparatus (bidder, col. 7, lines 51-65 and col. 11, lines 5-14) (claim 29); and

The processor transmits information indicative of the price component of the new bidding entity to the at least one bidding entity (cpu col. 8, lines 1-20 and col. 11, lines 5-32) (claim 36).

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Keiser, Silverman, Fraser, Giovannoli, Fisher, Godin, Berent, Randall and Miller patents are all directed to various types of online auctions or matching systems. The Mistr, Focsaneanu, Kenner, and Rieken patents are directed to various communications systems.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

ss

SANDRA S. SNAPP  
PATENT EXAMINER  
GROUP 3600